

The Manual of Patent Examining Procedures sets forth in Section 714.12 that “any amendment that would place the case either in condition for allowance or in better form for appeal may be entered.” Moreover, Section 714.13 sets forth that “the Proposed Amendment should be given sufficient consideration to determine whether the claims are in condition for allowance and/or whether the issues on appeal are simplified.” The Manual of Patent Examining Procedures further articulates that the reason for any non-entry should be explained expressly in the Advisory Action.

The Oath/Declaration

In items 4 and 5 on pages 2-3 of the Office Action, the Examiner rejected claims 1-22 under 35 U.S.C. §251 as being based upon a defective reissue declaration. The Examiner indicated that the declaration is defective because (a) it does not state whether the inventor is a sole or joint inventor of the invention claimed, and (b) the nature of the defect(s) in the declaration is that the error set forth as the basis for the reissue application is based on improper recapture. As indicated in item 6 on page 3 of the Office Action, the rejection of claims 8-22 under 35 U.S.C. §251 has been withdrawn. Applicants will submit a supplemental declaration upon allowance of the claims having prior art rejections.

Rejections Under 35 U.S.C. §§ 102 and 103

The Examiner rejected claims 8-10, 12-14, 16-18, and 20-22 under 35 U.S.C. §102(e) as being anticipated by Shear (U.S. Patent No. 5,410,598). The Examiner also rejected dependent claims 11, 15, and 19 under 35 U.S.C. §103(a) as being unpatentable over Shear in view of Allen (U.S. Patent No. 5,418,713). Applicants respectfully traverse these rejections for the reasons presented below.

Independent claim 8, as amended, recites that switch means switches a one-way connection “between one of said digital information receiving means and said information converting means, said digital information receiving means and said drive means, and said drive means and said information converting means.” Independent claims 12, 16, and 20-22 recite similar language.

The present invention receives data from two sources (i.e., digital information provided via a communication medium and digital information from a removable storage medium), and

provides the ability to switch one-way connections between the first source and the information converting means, between the second source and the information converting means, and between the two sources.

Referring to Fig. 3 of the Shear reference, Shear does not provide the switching operations as provided by the present invention. Shear connects to only one host computer through data connector 304. Thus, the decoder/biller 300 of Shear is limited to interpreting and processing data from one source and cannot switch between sources. In other words, Shear does not provide the capability to disconnect from one host computer and automatically connect to another host computer. In contrast, the present invention has the ability to receive data from two sources and to switch between the two sources. For example, in the present invention, data received via the Internet can be switched to the information converting means, data received via a CD-ROM can also be switched to the information converting means, and data received from the Internet can be switched to the removable storage medium for storage.

Further, Shear provides two-way communications, such as between the host computer 200 and the decoder control logic 316 shown in Fig. 3. In contrast, the switching operations of the present invention provide one-way communications.

As for the dependent claims, the dependent claims depend from the above-discussed independent claims and are patentable over the prior art for the reasons discussed above.

CONCLUSION

It is submitted that none of the references, either taken alone or in combination, teach the present claimed invention. Thus, claims 8-22 are deemed to be in a condition suitable for allowance. Reconsideration of the claims and an early Notice of Allowance are earnestly solicited.

If there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

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Finally, if there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Date: 1/7/02

Respectfully submitted,

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS

Please **AMEND** the following claims:

8. (TWICE AMENDED) An apparatus comprising:
digital information receiving means for receiving digital information provided via a communication medium;
drive means for reading digital information from, and writing digital information to, a removable storage medium;
information converting means for converting digital information received by said digital information receiving means and digital information read by said drive means into at least one of visible and audible data; and
switch means for switching a one-way connection between one of said digital information receiving means and said information converting means, said digital information receiving means and said drive means, and said drive means and said information converting means.

12. (TWICE AMENDED) An apparatus comprising:
a digital information receiver receiving digital information provided via a communication medium;
a drive device reading digital information from, and writing information to, a removable storage medium;
a converter converting digital information received by said digital information receiver and digital information read by said drive device into at least one of visible and audible data; and
a switch switching a one-way connection between said digital information receiver and said converter, between said digital information receiver and said drive device, and between said drive device and said converter.

16. (TWICE AMENDED) An apparatus comprising:
a communication path providing digital data;
a storage medium storing digital data;
a converter converting digital data into at least one of visible and audible data; and

a switch having

a first switch position which connects digital data provided by the communication path to the converter as a one-way connection so that the converter converts the digital data into at least one of visible and audible data,

a second switch position which connects digital data read from the storage medium to the converter as a one-way connection so that the converter converts the digital data read from the storage medium into at least one of visible and audible data, and

a third switch position which connects digital data provided by the communication path to the storage medium as a one-way connection so that the digital data provided via the communication path is stored in the storage medium.

20. (TWICE AMENDED) An apparatus comprising:

a communication path providing digital data;

a storage medium storing digital data;

a converter converting digital data into at least one of visible and audible data;

a decoder decoding encrypted digital data; and

a switch having

a first switch configuration which, when non-encrypted digital data is provided by the communication path, connects the digital information provided by the communication path to the converter as a one-way connection without passing through the decoder so that the converter converts the digital data into at least one of visible and audible data,

a second switch configuration which, when encrypted digital data is provided by the communication path, connects the digital information provided by the communication path to the converter and the decoder as a one-way connection so that the encrypted digital data is decoded by the decoder and then the decoded digital data is converted by the converter into at least one of visible and audible data,

a third switch configuration which, when non-encrypted digital data is read from the storage medium, connects the digital data read from the storage medium to the converter as a one-way connection without passing through the decoder so that the converter converts the digital data into at least one of visible and audible data,

a fourth switch configuration which, when encrypted digital data is read from the storage medium, connects the digital data read from the storage medium to the converter and

the decoder as a one-way connection so that the encrypted digital data is decoded by the decoder and then the decoded digital data is converted by the converter into at least one of visible and audible data, and

a fifth switch configuration which connects the digital data provided by the communication path to the storage medium as a one-way connection so that the digital data provided via the communication path is stored in the storage medium.

21. (TWICE AMENDED) A switch comprising:

a first switch position which connects digital data provided by a communication path to a converter as a one-way connection that converts the digital data into at least one of visible and audible data;

a second switch position which connects digital data read from a storage medium to the converter as a one-way connection so that the converter converts the digital data read from the storage medium into at least one of visible and audible data; and

a third switch position which connects the digital data provided by the communication path to the storage medium as a one-way connection so that the digital data provided via the communication path is stored in the storage medium.

22. (TWICE AMENDED) An apparatus comprising:

first means for connecting digital data provided by a communication path to a converter as a one-way connection that converts the digital data into at least one of visible and audible data;

second means for connecting digital data read from a storage medium to the converter as a one-way connection so that the converter converts the digital data read from the storage medium into at least one of visible and audible data; and

third means for connecting the digital data provided by the communication path to the storage medium as a one-way connection so that the digital data provided via the communication path is stored in the storage medium.